

REMARKS**Amendments to the Claims**

Claims 67-131 are pending in the current application. Claims 67, 84, 97, 111 and 119 have been amended in the preamble to recite that the claim is drawn to methods of determining the recited effect (e.g. inhibitors of cell growth, inhibitors of infection or producing a phenotypic effect) for cells *in vivo*. Claims 67, 84, 97, 111 and 119 were also amended to recite the words "*in vivo*" in step c), so that the claim language is consistent with the purpose recited in the preamble. Support for these amendments can be found throughout the specification and in claims 67, 84, 97, 111 and 119 prior to amendment.

Claims 69, 86, 99, 113 and 121 have been amended to recite the words "in culture" in step iii), to clarify that the effect referred to in step iii) is observed in culture. Support for these amendments can be found throughout the specification and in originally filed claims 69, 86, 99, 113 and 121.

Claims 71, 77, 88 and 92 have been amended to recite that the protein target "consists of a single gene product." Support for this amendment can be found on page 10, lines 6-7.

No new matter has been added.

Claim Objections under 37 CFR § 1.75(c)

Claims 71, 77, 88 and 92 were objected under 37 CFR §1.75(c), as being of improper dependent form for allegedly failing to further limit the subject matter of a previous claim. Applicants have amended claims 71, 77, 88 and 92 to recite a that the protein target consists of a single gene product.

As explained in the present application, a target component of a cell can be a single gene product or a complex comprising more than one gene product. *See, e.g.*, page

10, lines 5-9). As amended, claims 71, 77, 88 and 92 further limit the subject matter of the claims from which they depend.

Accordingly, Applicants respectfully submit that amended claims 71, 77, 88 and 92 comply with the requirements of 37 CFR § 1.75(c) and request reconsideration and withdrawal of the objection to these claims.

Claim Rejections under 35 U.S.C. § 112, second paragraph

Claims 69, 86, 99, 113 and 121 stand rejected under 35 U.S.C. §112, second paragraph, for allegedly failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action states:

[T]he claims specify in step (iii) that an observation of an effect on cells grown in culture (e.g. inhibited growth, inhibited infection or phenotypic effect) dictates that the expressed biomolecule (or peptide) causes the observed effect, while indicating in step (c) of the claim that an observation of the effect on the cells *in vivo* subsequent to step (iii) indicates that the biomolecule (or peptide) causes the effect. As the claims are written, it is not necessarily clear that one has achieved completion of the method after the *in vitro* step recited in step (iii) or after the *in vivo* step of step c).

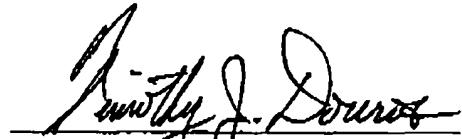
Applicants have amended the preambles of independent claims 67, 84, 97, 111 and 119 to recite that the claim is drawn to methods of determining the recited effect (e.g. inhibitors of cell growth, inhibitors of infection or producing a phenotypic effect) for cells *in vivo*. Claims 67, 84, 97, 111 and 119 have also been amended to recite, in step (c), that the effect is observed *in vivo*. In addition, claims 69, 86, 99, 113 and 121 have been amended to recite in step (iii) that the effect (i.e. inhibition of growth, phenotypic effect, etc) is observed in culture.

Accordingly, Applicants respectfully submit that amended claims 69, 86, 99, 113 and 121 are definite and request reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. §112, second paragraph.

CONCLUSION

For the reasons presented above, Applicants respectfully request entry of the present Preliminary Amendment and prompt allowance of all pending claims. The Commissioner is authorized to deduct any deficient amount or credit any surplus amount to Deposit Account No. 50-1986.

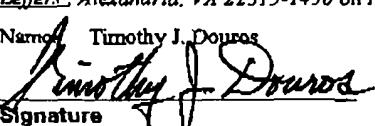
Respectfully submitted,



Timothy J. Douras
Registration No. 41,716
Attorney for Assignee
Jill M. Mandelblatt
Registration No. 37,878
Patent Agent for Assignee

Dated: November 21, 2003
Customer No.: 34103
Cubist Pharmaceuticals, Inc.
65 Hayden Avenue
Lexington, Massachusetts 02421
Tel.: (781) 860-8660
Fax: (781) 861-0566



CERTIFICATE OF FACSIMILE	
<p>I hereby certify that this correspondence is being sent via Facsimile to facsimile number (703) 872-9306 to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Attention: Examiner Letters, Alexandria, VA 22313-1450 on November 21, 2003.</p>	
Name:	Timothy J. Douras
Signature:	
November 21, 2003 Sig. Date	